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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338
20575	7590	03/09/2005	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 1030 SW MORRISON STREET PORTLAND, OR 97205			TON, ANTHONY T	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,330

Applicant(s)

MOLLOY, SCOTT THOMAS

Examiner

Anthony T Ton

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/19/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-548)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTIONS

Claim Objections

1. **Claim 1** is objected to because of the following informalities:

Term “a e-mail sender” in line 4 is improper.

Examiner suggests changing this term to “**an** e-mail sender”.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 5-8, 10, 13-18 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Henry* (US Patent No. 6,424,426).

a) **In Regarding to Claim 1:** *Henry* disclosed an ARPA-Internet Network

Access/Service provider device comprising:

a fax gateway (*see Fig.5: blocks 64 and 66*) including,

a storage device for storing an e-mail message received from an email sender for transmission to a fax receipt through a packet communications network, the stored e-mail message being converted to a fax document for transmission thereof to a fax recipient having access to a fax device (*see col.1 line 66- col.2 line 4: whereby a user is able to send emails (hence an email sender); Fig.2: block 26 E-mail Server; the Server can be considered as a*

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stored e-mail message storage device of the instant claim since it is used for email; and see col. 7 lines 1-10: the email-to-fax gateway 66 in Fig. 5 converts the MIME image into a text-formatted e.g. PostScript file. Then, the text-formatted file is rasterized into a fax encoded bit map image);

at least one fax modem device for transmitting the fax document to the fax recipient through a public switched telephone network (*see Fig. 2: block 20 fax Modem bank*),

wherein reception of the email message in the form of a fax document is not necessarily known to the email sender (*see Fig. 6: the advertisement part of a fax-to-email confirmation page*).

Henry fails to explicitly teach the ARPA-Internet Network Access/Service Provider device allows a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment.

However, *Henry* explicitly disclosed an ARPA-Internet Network Access/Service Provider device that allows a fax recipient to send e-mail messages by the use of a fax device without requiring computer equipment (*see Fig. 3B and col. 5 lines 3-15: a user interacts with the system 5 of the present invention to send an email from a fax machine*).

It was well known in the art that two-way communication is necessary for both sender and receiver to communicate, respectively. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such two-way communication to allow a fax recipient to receive e-mail messages by the use of a fax device without requiring computer equipment throughout the device, and allow a fax recipient to send e-mail messages by the use of a fax device without requiring computer equipment as taught by

Henry, the motivation being to enable the apparatus in *Henry* to support two-way communication.

b) In Regarding to Claim 2: *Henry* disclosed all aspects of this claim as set forth in claim 1.

Henry failed to explicitly teach the storage device further for storing a fax telephone number associated with the fax device of the fax recipient and for using the fax telephone number for establishing a call for the transmission of the fax document.

However, *Henry* explicitly disclosed a web server 88 connected to an IP router 82 in a network operation center as shown in Fig.7, wherein the web server 88 is used to capture and store the user's email address as well as the fax telephone number to which the user wishes to send the fax, and this fax telephone number is relayed over the Internet to the email server 26 (*considered as a stored email storage device of the instant claim*) of the preferably nearest POP 10 to which the fax telephone number is associated (*see col.8 lines1-11*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a web server 88, which can be connected to the IP router 32 in the device 10, as shown in Fig.2 of *Henry* for the purpose of reliably and automatically using in local calls because fax telephone number stored in the web server 88 is relayed over the Internet to the email server 26, the motivation being to reduce costs.

c) In Regarding to Claim 5: *Henry* further disclosed the storage device for further creating a fax cover page for transmission thereof to the fax recipient (*see Fig.8A: step 114*).

d) **In Regarding to Claim 6:** *Henry* further disclosed the e-mail message includes an e-mail address and the fax cover page includes a sender field extracted from the e-mail address (see Fig.4).

e) **In Regarding to Claim 7:** *Henry* further disclosed the Internet Network Access/Service Provider devices assigns an e-mail address to the fax recipient, the e-mail address being correlated to a fax telephone number identifying the fax device and wherein the fax cover page for further including a destination field extracted from the fax recipient e-mail address (see col.1 lines 35-42: *one type of service is that it requires the subscriber to have a specific telephone number associated with their email address; and see Fig.4: blocks 61 and 63 (destination field)*)).

f) **In Regarding to Claim 8:** *Henry* disclosed all aspects of this claim as set forth in claims 1 and 5-7; and

Henry further disclosed the Internet Network Access/Service Provider device for including the e-mail subject field contents in the fax cover page prior to transmission thereof to the fax recipient (see Fig.4: *box of Freehand Notes and Drawings*).

Henry fails to explicitly teach the e-mail message includes a subject field.

However, *Henry* explicitly disclosed a blank box for Freehand Notes and Drawings in Fig.4; by this box, it can be considered as both subject field and email subject contents because the subject field is just a blank line underneath the address field of an email message; before creating the contents of an email message, a fax sender can create the subject of the email message at the first line on the top of such a box.

Therefore, it would have been an obvious matter of design choice to provide such a subject field throughout the last "Cc:" field as shown in Fig.4 of *Henry* in order to the email format used by fax user can be the same as that of Internet emails, the motivation being to perform equally well with the regular emails.

g) In Regarding to Claim 10: *Henry* further disclosed the fax gateway is coupled to the public switching telephone network through one or more telephone lines (*see block POTS in Fig.1 and B1 lines in Fig.2*).

h) In Regarding to Claim 13: *Henry* further disclosed the storage device is a computer system having a conversion program for causing conversion of the e-mail message to a fax document (*see Fig.5 and col.5 line 2-37: software architecture*).

i) In Regarding to Claim 14: *Henry* further disclosed the storage device is a computer system having an e-mail program for causing storage of the e-mail message (*see col.6 line 34-50: SMTP protocol and software architecture*).

j) In Regarding to Claim 15: *Henry* further disclosed the e-mail program and the conversion program reside externally to the fax gateway (*see col.6 lines 44-50: all software modules could reside on a single server or on a different servers than is shown in the embodiment of Fig.5*).

k) In Regarding to Claim 16: *Henry* further disclosed the fax gateway further for receiving a reply fax document from the fax recipient, for converting the reply fax document to a reply e-mail message and for transmitting the reply e-mail message to the sender (*see Fig.8B: steps 120-126*).

l) **In Regarding to Claims 17 and 18:** These claims are rejected for the same reasons as claims 1 and 16, respectively because the apparatus in claims 1 and 16 can be used to practice the method steps of claims 17 and 18, respectively.

m) **In Regarding to Claim 21:** *Henry* disclosed a method for sending and receiving e-mail messages using a fax device as recited in Claim 17. This method can be applied to reject this claim for the same reasons as claim 17 because it is well known in the art that method steps can be programmed to automate a process.

Therefore, at the time of the invention, it is well known in the art that method steps can be programmed to automate a process. The resulting program is considered as firmware that the apparatus uses to perform the method steps to include in *Henry* this well-known art, so that a fax-to-email and email-to-fax communication system can be maintained properly. The motivation for doing so would have been to make *Henry's* fax device operate automatically. Therefore, it would have been obvious to include well-known art in *Henry* in the invention as specified in the claim.

4. **Claims 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Henry* (US Patent No. 6,424,426) in view of *Toyoda et al.* (provided by IDS #5) (US Patent No. 5,812,278) hereinafter referred to as *Toyoda*.

Henry disclosed all aspects of Claims 19 and 20 as set forth in the Claim 17.

Henry fails to explicitly teach further including the step of verifying a destination user address for identifying the fax recipient as being a known user as recited in Claim 19; and upon unsuccessful verification of the destination user address sending a failed message as recited in Claim 20.

Toyoda disclosed such verifying a destination user address and upon unsuccessful verification of the destination user address sending a failed message (see *Fig.29: steps 233, 241 and 244*).

At the time of the invention, it would be obvious to a person of ordinary skill in the art to provide such verifying a destination user address and upon unsuccessful verification of the destination user address sending a failed message, as taught by *Toyoda* with *Henry* in a purpose of notifying the sender that he/she has a wrong address of the destination and save bandwidth of transmitted. The motivation for doing so would have been to make *Henry* more efficient. Therefore, it would have been obvious to combine *Toyoda* with *Henry* in the invention as specified in the claim.

5. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Henry* (US Patent No. 6,424,426) in view of *Owens et al.* (US Patent No. 6,633,630) hereinafter referred to as *Owens*.

Henry disclosed all aspects of Claim 9 as set forth in the Claim 1.

Henry fails to explicitly teach the storage device for further assigning a mailbox for storage of e-mail messages directed to the fax recipient and upon receipt of the e-mail message, for storing the e-mail message within the assigned mailbox of the fax recipient.

Owens explicitly disclosed such a mailbox (see *col.2 lines 23-43: universal mailbox*).

At the time of the invention, it would be obvious to a person of ordinary skill in the art to provide such a mailbox, as taught by *Owens* with *Henry*, so that all different messages in different media such as email, voice mail and fax mail can be stored in a universal mailbox. The

motivation for doing so would have been to provide capabilities for same-media and cross-media notification and responses. Therefore, it would have been obvious to combine *Owens* with *Henry* in the invention as specified in the claim.

6. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Henry* (US Patent No. 6,424,426) in view of *Gidwani* (US Patent No. 6,640,239).

Henry disclosed all aspects of these claims as set forth in the claim 1; and

Henry further disclosed the fax gateway is coupled to the data communications network (see Fig.1: blocks of Internet and POP1).

Henry fails to explicitly teach wherein the fax gateway is coupled to the public switching telephone network through a digital communications link.

Gidwani explicitly disclosed such a digital communications link (see Fig.2: DSL).

At the time of the invention, it would be obvious to a person of ordinary skill in the art to provide such a digital communications link, as taught by *Gidwani* with *Henry* for the purpose of multiple services such as voice, data, video and signaling (see *Henry: the Internet access lines e.g. T-3 in col.4 lines 39-34*). The motivation for doing so would have been to make *Henry* more efficient. Therefore, it would have been obvious to combine *Gidwani* with *Henry* in the invention as specified in the claim.

7. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Henry* (US Patent No. 6,424,426) in view of *Toyoda et al* (US Patent No. 5,825,505) hereinafter referred to as *Toyoda 505*.

Henry disclosed all aspects of Claims 3 and 4 as set forth in the Claim 1.

Henry fails to explicitly teach wherein the storage device for further storing a time-of-day for specifying a range of time during which the fax document is transmitted; and

the storage device further for storing a fax telephone number associated with the fax device of the fax recipient and for using the fax telephone number for establishing a call for the transmission of the fax document.

Toyoda 505 explicitly disclosed such storing a time-of-day for specifying a range of time during which the fax document is transmitted (*see Fig.12: steps 65-71*).

At the time of the invention, it would be obvious to a person of ordinary skill in the art to provide such a digital communications link, as taught by *Toyoda 505* with *Henry* for the purpose of controlling the time of a fax document that is transmitted throughout communication systems. The motivation for doing so would have been to make *Henry* more efficient. Therefore, it would have been obvious to combine *Toyoda 505* with *Henry* in the invention as specified in the claim; and

Henry also disclosed a web server 88 connected to an IP router 82 in a network operation center as shown in Fig.7, wherein the web server 88 is used to capture and store the user's email address as well as the fax telephone number to which the user wishes to send the fax, and this fax telephone number is relayed over the Internet to the email server 26 (*considered as a stored email storage device of the instant claim*) of the preferably nearest POP 10 to which the fax telephone number is associated (*see col.8 lines1-11*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such a web server 88, which can be connected to the IP router

32 in the device 10, as shown in Fig.2 of *Henry* for the purpose of reliably and automatically using in local calls because fax telephone number stored in the web server 88 is relayed over the Internet to the email server 26, the motivation being to reduce costs.

Response to Remarks/Arguments

8. Applicant's arguments filed on 7/19/2004 have been fully considered but they are not persuasive. Claims 1-21, which remain in the subject application with claims 1, 7, 11, 17 and 21 were amended, have been respectfully reconsidered. However, all of these claims are still rejected as the same old ground of the rejection as described above.

In regarding to amended claims 1, 17 and 21: Examiner carefully reconsidered the subject matters of the claims. However, Examiner respectfully disagrees with the Applicants that in *Henry*, it is believed that there is no teaching of the e-mail sender being ignorant of the e-mail message being transmitted to the fax receipt in the form of a fax document. In fact, *Henry* explicitly discloses such the e-mail sender being ignorant of the e-mail message being transmitted to the fax receipt in the form of a fax document (*see the advertisement part of the MongoFax confirmation page in Fig.6*). In this confirmation page, a fax user at a fax receipt side would receive an advertisement in the form of a fax document without having any information relating to the e-mail sender. There is only a fax back number (xxx) xxx-xxxx that the fax user can use for a further interest.

It is therefore also believed that all claims depending therefrom cannot be patentable over *Henry* as well as *Toyoda*, *Owens* and *Gidwani*.

For the reasons above, the claims 1-21 are unpatentable and being still rejected as the same old ground of the rejection.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Anthony T Ton** whose telephone number is **571-272-3076**. The examiner can normally be reached on M-F: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Chau Nguyen** can be reached on **571-272-3126**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

by: 

Anthony T. Ton
Patent Examiner
February 22, 2005



**PHIRIN SAM
PRIMARY EXAMINER**